

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICANT: Boyce D. Burts, Jr. § EXAMINER: L. Cross
FILED: April 22, 1999 § § ART UNIT NO.: 1721
SERIAL NO.: 09/296,217 § §
TITLE: *Conformance Improvement* § ATTY DOCKET NO. 23267/15DC1
 § *Additive, Conformance Treatment* §
 § *Fluid Made Therefrom, Method* §
 § *of Improving Conformance in a* §
 § *Subterranean Formation* §

STATUS INQUIRY

OR

IN THE ALTERNATIVE
A PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37
CFR 1.181(a)

The Assistant Commissioner of Patents
Washington, DC 20231

Dear Sir:

This is a Status Inquiry as to the current status of this patent application. In the alternative, it is a Petition to Withdraw Holding of Abandonment Under 37 CFR 1.181(a).

REMARKS

The facts of this application are convoluted, and applicant thanks the Examiner in advance for the patience required to dig through these facts.

This application is not viewable on PAIR, so applicant requests a current status of the application, and in the alternative, it is a Petition to Withdraw Holding of Abandonment Under 37 CFR 1.181(a).

Quick Summary

In response to the 10/07/03 Notice, applicant

- (1) timely submitted a response to the notice;
- (2) submitted it a second time upon telephone inquiry by the Examiner and issuance of a Notice of Abandonment; and
- (3) submitted it a third time upon telephone inquiry by the Examiner.

In short, timely response was made, and copies were twice provided in response to the Notice of Abandonment and inquiries by the Examiner.

Timeline of Events

10/07/03 Notice of Non-Compliance With One Month Period for Response.

11/07/03 Timely Response was facsimile filed (see Exhibit A, Response; Exhibit B, Attorneys Fax generated confirmation; and Exhibit C, USPTO Auto Reply Receipt).

07/14/04 Examiner Cross kindly telephoned attorney Gilbreth and said a Response was not received and that the application appeared to be abandoned.

07/16/04 Notice of Abandonment.

07/19/04 A copy of the 11/07/03 Response was facsimile filed, along with proof of facsimile filing (See Exhibit D, Response to 7/14 phone call; Exhibit E, fax generated confirmation; Exhibit F, USPTO auto reply).

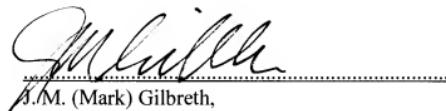
01/04/05 Examiner Cross again informs attorney Gilbreth that the Response has not been received.

01/06/05 Copy of the 11/07/03 Response, Copy of the 07/09/04 Response, along with proof of facsimile filing for both responses, were filed (See Exhibit G, Fax Cover Sheet listing Exhibits; Exhibit H, generated fax confirmation).

In view of the above arguments, prompt allowance of all pending claims is respectfully requested.

If it would be of assistance in resolving any issues in this application, the Examiner is kindly invited to contact applicants' attorney Mark Gilbreth at 713/227-1200.

Respectfully submitted,



J.M. (Mark) Gilbreth,
Registration No. 33,388
Attorney for Applicants

Date: December 10, 2007

Gilbreth & Associates, P.C.
PO Box 61305
Houston, Texas 77208-1305
713/227-1200

Exhibit A
Response as filed 11/07/03

PLEASE DELIVER TO:

Examiner LaToya Cross

Phone 703-305-7360

ART UNIT 1743

COMPANY: PATENT & TRADEMARK OFFICE
WASHINGTON, DC 20231

FAX NUMBER: 703-872-9306

TOTAL PAGES 5 Pages (Including Cover Sheet)

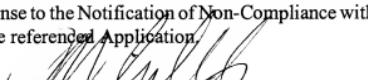
FROM: J.M. (Mark) Gilbreth, Reg No.: 33,388

RE: SERIAL NO. 09/296,217

**RESPONSE TO NOTIFICATION OF NON-COMPLIANCE WITH
THE REQUIREMENTS OF 37 CFR 1.192(C)**

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to **fax number (703) 872-9306**, Attn: **Examiner LaToya Cross**, Commissioner for Patents, Alexandria, VA 22313-1450, on **November 7, 2003**. Faxed herewith is the Response to the Notification of Non-Compliance with the Requirements of 37 CFR 1.192(c) for the above referenced Application.


J.M. (Mark) Gilbreth, Reg No. 33,388
/Attorney for Applicant

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICANT: Boyce D. Burts, Jr. § EXAMINER: L. Cross

FILED: April 22, 1999 § ART UNIT NO.: 1743

SERIAL NO.: 09/296,217

TITLE: *Conformance Improvement Additive, Conformance Treatment Fluid Made Therefrom, Method of Improving Conformance in a Subterranean Formation* § **ATTY DOCKET NO. 23267/15DC1**

RESPONSE TO THE NOTIFICATION OF NON-COMPLIANCE WITH THE REQUIREMENTS OF 37 CFR 1.192(C)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the Notification of Non-Compliance with the Requirements of 37 CFR 1.192(c) of October 7, 2003, correct copies of claims 4 and 6 are respectfully submitted. Additionally, Section II of the Appeal Brief is updated to reflect decisions on 09/296,216 and 09/307,544.

REMARKS

Correct Copy Of Claims 4 and 6:

The Notification is requiring submission of the correct copy of claims 4 and 6.

It appears that claims 4 and 6 as listed in the Appeal Brief lacked amendments filed December 14, 1999, in response to the Office action of July 21, 1999. The following copy of claims 4 and 6 reflect that amendment.

4. The additive of claim 3 wherein the hydrophobic fibers comprise at least one selected from the group of hydrophobic fibers consisting of nylon, rayon, and hydrocarbon fibers, and wherein the hydrophilic fibers comprise at least one selected from the group of hydrophilic fibers consisting of glass, cellulose, carbon, silicon, graphite, calcined petroleum coke, and cotton fibers.

6. The additive of claim 5 wherein the reinforcing material comprises at least one comminuted material selected from the group of comminuted plant materials consisting of nut and seed shells or hulls of almond, brazil, cocoa bean, coconut, cotton, flax, grass, linseed, maize, millet, oat, peach, peanut, rice, rye, soybean, sunflower, walnut, and wheat; rice tips; rice straw; rice bran; crude pectate pulp; peat moss fibers; flax; cotton; cotton linters; wool; sugar cane; paper; bagasse; bamboo; corn stalks; sawdust; wood; bark; straw; cork; dehydrated vegetable matter; whole ground corn cobs; corn cob light density pith core; corn cob ground woody ring portion; corn cob chaff portion; cotton seed stems; flax stems; wheat stems; sunflower seed stems; soybean stems; maize stems; rye grass stems; millet stems; and mixtures thereof.

UPDATE OF SECTION II OF THE APPEAL BRIEF

BOARD DECISION ON COPENDING S/N 09/307,544

As an update, applicant wishes to direct attention to Board Decision dated July 17, 2003 for Application S/N 09/307,544 (Appeal No. 2003-0604) in which very similar claims (well plug additive comprising a dry mixture of polymer/crosslinking agent/reinforcing material, and method of making) were rejected under 35 USC 103 over the same art of record (Horner et al., Githens, Sydansk, House et al., and Merrill).

The Board stated that the common issue of the 103 rejections, "is whether the examiner has provided a proper factual foundation supporting her conclusion that one of ordinary skill in the art would have expected that the addition of inert solids (for example, sand), before activation with water, rather than after activation with water, would provide no substantial difference in results."

After finding a "lack of factual foundation," the Board reversed the 103 rejections.

BOARD DECISION ON COPENDING S/N 09/296,216

As another update, applicant further respectfully directs attention to Board Decision dated September 15, 2003 for Application S/N 09/296,216 (Appeal No. 2003-0515) in which very similar claims for a conformance additive were rejected under 35 USC 103 over the same art of record (Horner et al., Githens, Sydansk, House et al., and Merrill). In that Decision, the Board adopted the July 17, 2003 Board Decision, and again reversed the 103 rejections.

If it would be of assistance in resolving any issues in this application, the Examiner is kindly invited to contact applicants' attorney Mark Gilbreth at (713) 667-1200.

Respectfully submitted,



J. M. (Mark) Gilbreth, Registration No. 33,388
Attorney for Applicants

Date: November 7, 2003

GILBRETH & ASSOCIATES, P.C.
P.O. Box 2428
BELLARE, TX 77402-2428
T (713) 667-1200
F (713) 667-4424

Exhibit B
Attorneys Fax generated confirmation 11/07/03

*** TX REPORT ***

TRANSMISSION OK

TX/RX NO 0607
CONNECTION TEL 17038729306
SUBADDRESS
CONNECTION ID
ST. TIME 11/07 17:35
USAGE T 02 '18
PGS. 5
RESULT OK

1736

**FACSIMILE
TRANSMITTAL**

GILBRETH & ASSOCIATES, P.C.

6750 W. Loop South, Suite 920

Bellaire, Texas 77401

Telephone (713) 667-1200

Facsimile (713) 667-4424

PLEASE DELIVER TO:

Examiner LaToya Cross

Phone 703-305-7360
ART UNIT 1743

COMPANY: PATENT & TRADEMARK OFFICE
WASHINGTON, DC 20231

FAX NUMBER: 703-872-9306

TOTAL PAGES 5 Pages (Including Cover Sheet)

FROM: J.M. (Mark) Gilbreth, Reg No.: 33,388

RE: SERIAL NO. 09/296,217

RESPONSE TO NOTIFICATION OF NON-COMPLIANCE WITH
THE REQUIREMENTS OF 37 CFR 1.192(C)

CERTIFICATE OF FACSIMILE TRANSMISSION

Exhibit C
USPTO Auto Reply Receipt 11/07/03

FILE

Auto-Reply Facsimile Transmission



TO: Fax Sender at 7136674424
Fax Information
Date Received: 11/7/03 6:34:24 PM [Eastern Standard Time]
Total Pages: 5 (including cover page)

ADVISORY: This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMEP) section 306 et seq.

Received
Cover
Page
=====>

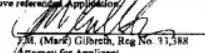
11/07/03 FRI 17:53 FAX 7136674424		GILBRETH & ASSOC	1001
FACSIMILE TRANSMITTAL		GILBRETH & ASSOCIATES, P.C. 6750 W. Loop South, Suite 900 Bellaire, Texas 77401 Telephone (713) 667-1200 Facsimile (713) 667-4424	
PLEASE DELIVER TO:			
Examiner LaToya Cross			
Phone 703-305-7360			
ART UNIT 1743			
COMPANY:	PATENT & TRADEMARK OFFICE WASHINGTON, DC 20231		
FAX NUMBER:	703-972-9306		
TOTAL PAGES	5 Pages (Including Cover Sheet)		
FROM:	J.M. (Mark) Gilbreth, Reg No. 33,388		
RE:	SERIAL NO. 09/296,217		
RESPONSE TO NOTIFICATION OF NON-COMPLIANCE WITH THE REQUIREMENTS OF 37 CFR 1.192(C)			
CERTIFICATE OF FACSIMILE TRANSMISSION			
I hereby certify that this correspondence is being facsimile transmitted to fax number (703) 872-9306, Attn: Examiner LaToya Cross, Commissioner for Patents, Alexandria, VA 22311-1450, on November 7, 2003. Faxed herewith is the Response to the Notification of Non-Compliance with the Requirements of 37 CFR 1.192(c) for the above referenced Application.			
 J.M. (Mark) Gilbreth, Reg No. 33,388 Attorney for Applicant			
G&A Docket No. 23587/USDC1			
Received from 7136674424 on 11/07/03 6:34:24 PM [Eastern Standard Time]			

Exhibit D
Response to 7/14 phone call as filed 07/19/04

**FACSIMILE
TRANSMITTAL**

GILBRETH & ASSOCIATES, P.C.

6750 W. Loop South, Suite 920

Bellaire, Texas 77401

Telephone (713) 667-1200

Facsimile (713) 667-4424

PLEASE DELIVER TO:

Examiner LaToya Cross
Phone 703-305-7360
ART UNIT 1743

COMPANY: PATENT & TRADEMARK OFFICE
WASHINGTON, DC 20231

FAX NUMBER: 703-872-9306

TOTAL PAGES 10 Pages (Including Cover Sheet)

FROM: J.M. (Mark) Gilbreth, Reg No.: 33,388

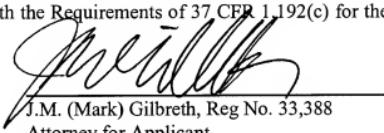
RE: SERIAL NO. 09/296,217

RESPONSE TO 7/14 EXAMINER PHONE CALL

***AND COPY OF PREVIOUSLY FILED RESPONSE TO NOTIFICATION
OF NON-COMPLIANCE WITH THE REQUIREMENTS OF 37 CFR 1.192(C)***

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to **fax number (703) 872-9306**, Attn: **Examiner LaToya Cross**, Commissioner for Patents, Alexandria, VA 22313-1450, on **July 19, 2004**. Faxed herewith is the Response to Phone Call and copy of previously filed Response to Notification of Non-Compliance with the Requirements of 37 CFR 1.192(c) for the above referenced Application.



J.M. (Mark) Gilbreth, Reg No. 33,388
Attorney for Applicant

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICANT: Boyce D. Burts, Jr. § EXAMINER: L. Cross
§
FILED: April 22, 1999 § ART UNIT NO.: 1743
§
SERIAL NO.: 09/296,217 §
§
TITLE: *Conformance Improvement* § ATTY DOCKET NO. 23267/15DC1
Additive, Conformance Treatment §
Fluid Made Therefrom, Method §
of Improving Conformance in a §
Subterranean Formation §

RESPONSE TO 7/14/04 EXAMINER PHONE CALL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is responsive to a telephone call from Examiner LaToya Cross on July 14, 2004.

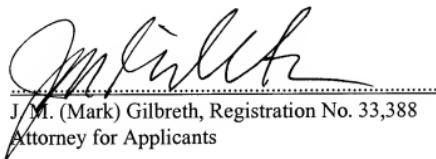
Examiner Cross called to notify applicant's attorney Mark Gilbreth that the application appeared to have been abandoned for applicant's failure to respond to a 10/7/2003 Notification, Examiner Cross could find no response in the file.

It is respectfully noted that applicant fax filed a timely response 11/7/2003. A copy of that response is faxed herewith, along with the "Auto-Reply Facsimile Transmission" from the USPTO.

If it would be of assistance in resolving any issues in this application, the Examiner is kindly invited to contact applicants' attorney Mark Gilbreth at (713) 667-1200.

Respectfully submitted,

Date: 7/19/2004


J. M. (Mark) Gilbreth, Registration No. 33,388
Attorney for Applicants

Gilbreth & Associates, P.C.
P.O. Box 2428
Bellaire, TX 77402-2428
T (713) 667-1200
F (713) 667-4424

Exhibit E
fax generated confirmation 7/19/04

*** TX REPORT ***

TRANSMISSION OK

TX/RX NO	0765
CONNECTION TEL	17038729306
SUBADDRESS	
CONNECTION ID	
ST. TIME	07/19 21:31
USAGE T	03 '19
PGS.	10
RESULT	OK

**FACSIMILE
TRANSMITTAL**

GILBRETH & ASSOCIATES, P.C.

6750 W. Loop South, Suite 920

Bellaire, Texas 77401

Telephone (713) 667-1200

Facsimile (713) 667-4424

PLEASE DELIVER TO:

Examiner LaToya Cross
Phone 703-305-7360
ART UNIT 1743

**COMPANY: PATENT & TRADEMARK OFFICE
WASHINGTON, DC 20231**

FAX NUMBER: 703-872-9306

TOTAL PAGES 10 **Pages (Including Cover Sheet)**

FROM: J.M. (Mark) Gilbreth, Reg No.: 33,388

RE: SERIAL NO. 09/296,217

RESPONSE TO 7/14 EXAMINER PHONE CALL

**AND COPY OF PREVIOUSLY FILED *RESPONSE TO NOTIFICATION
OF NON-COMPLIANCE WITH THE REQUIREMENTS OF 37 CFR 1.192(C)***

CERTIFICATE OF FACSIMILE TRANSMISSION

Exhibit F
USPTO auto reply 07/19/04

Auto-Reply Facsimile Transmission



TO: Fax Sender at 7136674424

Fax Information
Date Received: 7/19/2004 11:29:48 PM [Eastern Daylight Time]
Total Pages: 10 (including cover page)

ADVISORY: This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMEP) section 306 et seq.

Received
Cover
Page
=====>

07-19-04 11:29:48 PM 7136674424 GILBRETH & ASSOC. 0001
FACSIMILE TRANSMITTAL **GILBRETH & ASSOCIATES, P.C.**
6750 W. Loop South, Suite 920
Belieire, Texas 77401
Telephone (713) 667-1200
Facsimile (713) 667-4424

PLEASE DELIVER TO:

Examiner LaToya Cross
Phone 703-305-7360
ART UNIT 1743

COMPANY: PATENT & TRADEMARK OFFICE
WASHINGTON, DC 20231

FAX NUMBER: 703-972-9306

TOTAL PAGES: 10 Pages (Including Cover Sheet)

FROM: J.M. (Mark) Gilbreth, Reg No. 33,388

RE: SERIAL NO. 09/296,217

RESPONSE TO 7/14 EXAMINER PHONE CALL

**AND COPY OF PREVIOUSLY FILED RESPONSE TO NOTIFICATION
OF NON-COMPLIANCE WITH THE REQUIREMENTS OF 37 CFR 1.192(C)**

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to fax number (703) 872-9306, Attn: Examiner LaToya Cross, Commissioner for Patents, Alexandria, VA 22313-1100, on July 19, 2004. Faxed herewith is the Response in Phone Call and copy of previously filed Response to Notification of Non-Compliance with the Requirements of 37 CFR 1.192(c) for the above referenced Application.


J.M. (Mark) Gilbreth, Reg No. 33,388
Attorney for Applicant

Exhibit G
Fax Cover Sheet filed 01/06/05 listing Exhibits

**FACSIMILE
TRANSMITTAL**

GILBRETH & ASSOCIATES, P.C.

6750 West Loop South, Suite 920

Bellaire, Texas 77401

Telephone No. 713/227-1200

Telecopier No. 713/667-4424

To the United States Patent and Trademark Office

PLEASE DELIVER TO:

Examiner LaToya Cross

Phone: 571 272 1256

FAX NUMBER: 571 273 1256

TOTAL PAGES -19- **Pages (Including Cover Sheet)**

FROM: J. M. (Mark) Gilbreth

RE: PAT APP SERIAL NO. 09/296,217

Following up on the 1/4/5 Telephonic Interview between Examiner Cross and applicant's attorney Mark Gilbreth, faxed herewith, please find:

Exhibit 1, Response and Fax Cover Sheet, Fax Filed 11/7/2003;

Exhibit 2, Fax Confirmation Generated by Attorney's Fax;

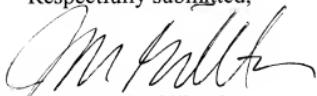
Exhibit 3, Fax Confirmation from USPTO;

Exhibit 4, Response to 7/14/04 Phone Call (resubmission of 11/7/03 Response);

Exhibit 5, Fax Confirmation Generated by Attorney's Fax;

Exhibit 6, Fax Confirmation from USPTO;

Respectfully submitted,



J. M. (Mark) Gilbreth

Reg. No. 33,388

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence and attachments referred to therein are being facsimile transmitted to **fax number** 571 273 1256, Attn: Ex. LaToya Cross, United States Patent and Trademark Office, on 1/6/05

Exhibit H
generated fax confirmation 01/06/05

*** TX REPORT ***

TRANSMISSION OK

TX/RX NO	0830
CONNECTION TEL	15712731256
SUBADDRESS	
CONNECTION ID	
ST. TIME	01/06 09:02
USAGE T	05'32
PGS.	19
RESULT	OK

**FACSIMILE
TRANSMITTAL**

GILBRETH & ASSOCIATES, P.C.

6750 West Loop South, Suite 920
Bellaire, Texas 77401
Telephone No. 713/227-1200
Telecopier No. 713/667-4424

To the United States Patent and Trademark Office
PLEASE DELIVER TO:

Examiner LaToya Cross

Phone: 571 272 1256

FAX NUMBER: 571 273 1256

TOTAL PAGES -19- **Pages (Including Cover Sheet)**

FROM: J. M. (Mark) Gilbreth

RE: PAT APP SERIAL NO. 09/296,217

Following up on the 1/4/5 Telephonic Interview between Examiner Cross and applicant's attorney Mark Gilbreth, faxed herewith, please find:

Exhibit 1, Response and Fax Cover Sheet, Fax Filed 11/7/2003;
Exhibit 2, Fax Confirmation Generated by Attorney's Fax;
Exhibit 3, Fax Confirmation from USPTO;
Exhibit 4, Response to 7/14/04 Phone Call (resubmission of 11/7/03 Response);
Exhibit 5, Fax Confirmation Generated by Attorney's Fax;
Exhibit 6, Fax Confirmation from USPTO;

Respectfully submitted,

